

O/121/21

Trade Marks Act 1994

IN THE MATTER IF APPLICATION 3472725

BY HUSTLER SPIRIT LTD

TO REGISTER THE FOLLOWING SERIES OF THREE TRADE MARKS IN CLASS

25



Hustler With A Cause

Trade Marks Act 1994

In the matter of application no 3472725

In the name of Hustler Spirit LTD

To register the following series of three trade marks in Class 25



Hustler With A Cause

Background

1. On 05 March 2020 Hustler Spirit LTD (“the applicant”) applied to register the above series of three marks for the following goods:

Class 25: T-shirts; Sportswear; Swim shorts; Swim suits; Swim trunks; Swim wear for children; Swimming costumes; Caps [headwear]; Caps with visors; Children's clothing; Childrens' clothing; Children's footwear; Children's headwear; Clothing; Clothing for children; Clothing for sports; Clothing made of leather; Clothing of leather; Coats; Coats for men; Coats for women; Coats of denim; Jackets; Jackets being sports clothing; Jackets [clothing]; Jumpers; Jumpers [pullovers]; Jumpsuits; Athletic footwear; Athletics shoes; Boots; Boys' clothing; Bralettes; Bras; Briefs [underwear]; Half-boots; Halter tops; Hats; Headwear; Heels; High-heeled shoes; Hooded tops; Hoodies; Babies' clothing; Babies' undergarments; Baby bibs [not of paper]; Baby bodysuits; Baby boots; Baby clothes; Baby tops; Ballet shoes; Ballet slippers; Beach clothes; Beach clothing; Beach footwear; Belts [clothing]; Belts for clothing; Belts made from imitation leather; Belts made of leather; Belts made out of cloth; Belts (Money -) [clothing]; Berets; Bikinis; Blue jeans; Bodices [lingerie]; Bodies [clothing]; Body stockings; Body suits; Body warmers; Bodysuits; Boiler suits; Lace boots; Ladies' clothing; Ladies' dresses; Ladies' footwear; Ladies' outerclothing; Ladies' underwear; Latex clothing; Leather belts [clothing]; Leather clothing; Leather coats; Leather dresses; Leather garments; Leather headwear; Leg warmers; Leggings [leg warmers]; Leggings [trousers]; Leotards; Lingerie; Long jackets; Long sleeved vests; Long-

sleeved shirts;Men's and women's jackets, coats, trousers, vests;Men's clothing;Men's dress socks;Men's sandals;Men's socks;Men's underwear;Menswear;Miniskirts;Mittens;Moccasins;Money belts [clothing];Muffs;Mules;Shoes;Shoes for infants;Shorts;Skirts;Slippers;Socks;Socks for infants and toddlers;Sport coats;Sport shoes;Sports bibs;Sun visors;Wedge sneakers;Winter boots;Winter coats;Women's clothing;Women's shoes;Womens' underclothing;Women's underwear;Wooden shoes;Wooden shoes [footwear];Woolen clothing;Woolly hats;Tank tops;Tee-shirts;Tights;Tops;Tops [clothing];Tracksuit bottoms;Tracksuit tops;Tracksuits;Trainers;Trainers [footwear];Fake fur hats;Flat shoes;Flip-flops;Flip-flops for use as footwear;Footwear;Footwear [excluding orthopedic footwear];Footwear for men;Footwear for men and women;Footwear for sport;Footwear for sports;Footwear for women;Fur hats;Fur jackets;Fur muffs;Fur stoles;Furs [clothing];Veils;Vest tops;Vests;Visors;Visors being headwear.

2. On 16 March 2020, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report an objection was raised under section 41(2) of the Trade Mark Act 1994 ("the Act") and the applicant was given until 18 May 2020 to respond. They were advised should they not do so the application would be refused under section 37(4) of the Act.
3. The section 41(2) objection was based on the fact that there are material differences between the three marks. It was considered that the first two marks were figurative marks and contained stylised letters not present in the third mark, plus the overall stylisation in the first two marks was not present in the third mark.
4. The examination report advised that marks one and two could be considered as a series; the applicant could, therefore, either proceed in respect of marks one and two as a series, or mark three as an individual mark. To do this the examiner advised the IPO would need to be informed of which mark, or marks, the applicant wished to remove from the application to overcome the objection.
5. Rule 28 of the Trade Mark Rules 2008 outlines the ability to apply for a series of mark.

28.—(1) The proprietor of a series of trade marks may apply to the Registrar on Form TM3 for their registration as a series in a single registration and there shall be included in such application a representation of each mark claimed to be in the series.

(2) Following an application under paragraph (1) the Registrar shall, if satisfied that the marks constitute a series, accept the application.

6. Rule 28 also enables an applicant to remove a mark from a series application.

(5) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series and, following such request, the Registrar shall delete the mark accordingly.

7. On the 27 March 2020 the IPO declared on the www.gov.uk website a period of interrupted days which began on 24 March 2020 due to the coronavirus pandemic. This is in line with section 75 of the Trade Mark rules 2008 which states:

“75.—(1) The Registrar may certify any day as an interrupted day where—

there is an event or circumstance causing an interruption in the normal operation of the Office; or

(b) there is a general interruption or subsequent dislocation in the postal services of the United Kingdom.

(2) Any certificate of the Registrar made under paragraph (1) shall be displayed in the Office and published on the Office website.

(3) The Registrar shall, where the time for doing anything under these Rules expires on an interrupted day, extend that time to the next following day not being an interrupted day (or an excluded day).

(4) In this rule—

“excluded day” means a day which is not a business day as specified in a direction given by the Registrar under section 80; and “interrupted day” means a day which has been certified as such under paragraph (1).”

8. This stated that whilst the office remained operational, any deadline drawn from a time periods set out in the various relevant UK Acts and Rules or from a non-statutory period specified by staff would be extended to the next non-interrupted day. Further, to ease the burden on rights holders a minimum of two weeks' notice would be given before the interrupted days period would end. As such this meant the deadline day would no longer necessarily be 18

May 2020 but would fall on the first non-interpreted day, should this be after 18 May 2020.

9. On 22 April 2020 the office provided confirmation that the interrupted days would continue. This was followed by further communication on 7 May 2020 advising that following a review the office would continue with the period of interrupted days. The IPO advised the next review would be on 28 May 2020 and re-affirmed a minimum of two weeks' notice would be given before the interrupted days period would end.
10. On 12 May the examiner wrote to the applicant advising of the position. The applicant was directed to the website and informed that the deadline given in the correspondence dated 16 March 2020 would be extended until the IPO gives notice of the end of the interrupted days period. A copy of the examination report was provided as an attachment for the applicant's convenience.
11. On 29 May it was confirmed that following the review the period of interrupted days would continue and the next date of review was provided.
12. On 22 June an update was provided that interrupted days would end on 29 July 2020. Therefore, the first normal day of operation when all interrupted days deadlines expired would be Thursday 30 July 2020.
13. Although the update of 22 June meant that the deadline to reply to this application was 30 July the examiner made a final attempt to contact the applicant on 12 August 2020. In this correspondence the applicant was given a new deadline of 18 August 2020. A copy of the examination report was provided again for the applicant's convenience.
14. As no response was received on 21 August 2020 a refusal letter was issued advising the application was refused under section 37(4) of the Act. The applicant was advised of their right to appeal the action and that to do so they would need to request a statement of grounds by 21 September 2020. The applicant was advised that this request would need to be made by filing Form TM5 with the appropriate fee.
15. On 21 September 2020 the applicant responded asking that the third mark be removed and at the same time Form TM 5 was filed requesting a statement of grounds for the Registrar's decision.

Decision

16. In the examination report of 16 March 2020, it was explained that a failure to reply to the objection under section 41(2) by the deadline would result in the application being refused under section 37(4). Although the official letter of

the 12 May did not provide a set deadline, due to the period of interrupted days, the advice therein and on the website made clear that the deadline would be reinstated once the interrupted days period ended. The official letter of 12 August 2020, and the new deadline it gave, restated that the application would be refused under section 37(4) if there was no response.

17. The applicant has only attempted to make changes after the deadline. The provisions governing the examination of trade mark application are set out in Section 37 of which sub-section (4) provides the Registrar with the grounds for refusing an application. Section 37(4) says the following:

“If the applicant fails to satisfy the Registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse to accept the application.”

18. Section 37(4) is a mandatory provision. The Registrar is obligated to refuse to accept an application when the specified period has ended, and the applicant has either failed to amend the application or failed to respond.

19. The Trade Mark Rules 2008 enables for the extension of time limits.

77.—(1) Subject to paragraphs (4) and (5), the Registrar may, at the request of the person or party concerned or at the Registrar’s own initiative extend a time or period prescribed by these Rules or a time or period specified by the Registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the Registrar may direct.

(2) A request for extension under this rule may be made before or after the time or period in question has expired and shall be made—

(a) where the application for registration has not been published and the request for an extension is made before the time or period in question has expired, in writing; and

(b) in any other case, on Form TM9.

20. No request under the rules was made by the applicant to extend the time period. As such the specified time period must be considered to have ended and the duty of the Registrar must be to refuse the application.

21. Even if the applicant had made a timely application to extend the relevant period and the Registrar had accepted those reasons, I want to make clear as to why the substantive objection in relation to the marks not being a series holds good. The original examination report confirmed that in isolation the

marks were acceptable; however, that the three marks could not constitute a single series.

22. Although there were no absolute grounds objections against any of the marks, it is solely the applicant's responsibility to make such the selection. As the applicant made no attempt to select one of the marks within the given time frame the examiner's decision to refuse the mark was correct, and in accordance with established law and practice.
23. Had the need for an applicant's response been prompted by ex officio objections which were subsequently deemed to be unfounded, then the Registrar's refusal pursuant to section 37(4) may be called into question. For the avoidance of doubt and to ensure legal certainty I have presented below a review of the objection under section 41(2).

Section 41(2)

24. The trade mark act 1994 allows a 'series' of marks to be registered. The definition of a series is given at section 41(2)

"A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark."

25. Therefore, in order to function as a series in accordance with section 41(2), the marks must resemble each other and the differences between the marks must only be of a non-distinctive character and must not substantially affect the overall identity of the signs.

26. This concept of 'overall identity' was considered by Jacob J in Neutrogena Corporation v Golden Limited [1996] RPC 473:

"Not substantially affecting its identity' means what it says, both in this section and in other sections of the Act (e.g. section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test."

27. This view was restated and approved by Professor Ruth Annand Q.C. acting as the AP in LOGICA (BL O/068/03).

"Turning to the meaning of "not substantially affecting the identity of the trade mark", I believe it would be hard to improve on Jacob J.'s observation in Neutrogena Corporation v. Golden Limited [1996]"

28. In the Logica decision Professor Annand further clarified the considerations over a series.

“First, on the positive side, section 41(2) requires the trade marks for which series registration is sought to resemble each other in their material particulars.

Second and third, the negative aspects are that any difference in the trade marks must not comprise matter, which when considered:

(a) as a separate element of the trade mark would be regarded as having distinctive character; and

(b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark.

29. In *Glee [2016] EWCA Civ 455*, Lord Justice Kitchin helpfully summarised the requirements under section 41(2):

“Pausing here, the requirements imposed by s.41(2) may be summarised as follows. In order to qualify as a series the trade marks must resemble each other in their material particulars. Any differences between the trade marks must be of a non-distinctive character and must leave the visual, aural and conceptual identity of each of the trade marks substantially the same. These matters must be assessed from the perspective of the average consumer of the goods or services in question.”

30. In order to satisfy the requirements of section 41(2) of the Act, all three marks applied for, whilst differing from one another, must resemble each other as to their material particulars and differ only in respect of non-distinctive matter which does not substantially affect the identity of the marks.
31. All three marks contain the words ‘HUSTLER WITH A CAUSE’; the first two marks contain additional matter, whilst the third consist of the words alone.
32. The first and second mark contain stylised letters and a stylised appearance. The letters dominate the mark. If these letters are spoken as initials, they would affect the aural identities of the marks. Crucially also the stylised letters, alongside the stylisation in the shared words, have a significant impact visually on the marks. Because of the dominance of the letters in the first two marks it is conceivable also that a conceptual difference may arise with the marks, being that the first two marks will be recalled by the letters ‘HWAC’ rather than the full phrase.
33. In summary, taking account of the visual, aural and conceptual differences there is no doubt in my mind that the requirement for the overall identity to remain the same for marks in a series, has been compromised.
34. I accept the examiner was correct that the marks do not meet the criteria for acceptance as a series of marks, therefore the objection taken under section 41(2) was correctly raised.

Conclusion

35. I have considered all the correspondence issued by the examiner. Although the applicant has attempted to enact changes to overcome the objection under section 41(2) this was only after the marks had been refused and without proper reason in accordance with the rules. As such I have no arguments to consider from the applicant why they feel the initial objection was incorrect, nor was there any indication within the deadline which would have enabled the examiner to interpret the applicant's intentions. It is therefore found for the procedural reasons given above, that the application is refused for a failure to respond under section 37(4) of the Act.

Dated this 24th day of February 2021

**Joseph Allen
For the Registrar
The Comptroller-General**